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OFFICE OF PETITIONS

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Patent No. 7,571,132 :
Cole :
Issue Date: August 4, 2009 :
Application No. 10/052,419 : DECISION ON REQUEST FOR
Filed: January 18, 2002 : RECONSIDERATION OF
Attorney Dkt. No. 10850.0001-00 : PATENT TERM ADJUSTMENT
Title: Forfeiting Transaction :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT," filed October 02, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from one thousand five hundred ninety-four (1594) days to two thousand two hundred sixty-six (2266) days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On August 4, 2009, the above-identified application matured into US Patent No. 7,571,132 with a patent term adjustment of 1594 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that 761 of 1659 days due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), does not overlap with the 1570 day period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), as these periods do not occur on the same day. Thus,

patentees request that the determination of patent term adjustment be increased to a total of two thousand two hundred sixty-six (2266 days) (the sum of the period of three-year delay (1659 days) and the period of examination delay (1570 days) less applicant delay (65) days less overlap (898 days)).

The Office finds that as of the issuance of the patent on August 4, 2009, the application was pending three years and 1659 days after its filing date (January 18, 2005 to August 4, 2009). A period of adjustment of 1570 days was entered for Office delay pursuant to 37 CFR 1.702(a)(1) and (a)(4).¹ At issue is whether patentee should accrue an additional 1659 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 1570 days for Office failure to take a certain action within a specified time frame (or examination delay).

Patentee's calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C.

¹ It should also be noted that 89 days was entered upon issuance of the patent pursuant to 37 CFR 1.703(b).

154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, January 18, 2002 until the issuance of the patent on August 4, 2009. 1570 days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within specified time frames during the pendency of the application. Entry of both 1659 days pursuant to 37 CFR §1.702(b) and 1570 days pursuant to 37 CFR §1.702(a) is neither permitted nor warranted. The Office did not delay 1570 days and then another 1659 days. The greater period, 1659 days, is the actual number of days

issuance of the patent was delayed by the Office. All but 89 days of the periods pursuant to 37 CFR §§1.702(a) and 1.702(b) overlap. Accordingly, at issuance the Office entered an additional 89 days of patent term adjustment for taking in excess of three years to issue the patent for a total Office delay of 1659 days.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent was 1594 (1570 + 89 - 65) days.

In view thereof, no adjustment to the patent term will be made.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Petitions Attorney, at (571) 272-3215.

/Kery A. Fries/

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration
Office of Deputy Commissioner
For Patent Examination Policy